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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,684	07/10/2003	Ronald E. Dooley	270600/M131B	2570
4743	7590	12/19/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			MACKEY, PATRICK HEWEY	
			ART UNIT	PAPER NUMBER
			3651	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/616,684	Applicant(s) DOOLEY, RONALD E.	
	Examiner Patrick H. Mackey	Art Unit 3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☒ Claim(s) 16-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 10/14/05 has been entered.

Reissue Applications

1. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 27, 28, 30, and 31-34 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16, 21, 25, 27, 28, 31, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osako et al. in view of Meier. Osako discloses a binding line (117) for gathering a plurality of signatures (301) to form a book that includes a plurality of packer boxes (119, 124), and a feeder system associated with the packer boxes including a conveyor (111) having an output end and a plurality of feeders (113). Osako discloses all the limitations of the

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claims, but it does not disclose a controller to activate the feeders (113). However, Meier discloses a device for gathering signatures (see col. 1, line 20) that includes a plurality of packer boxes (12), a feeder system (2-5) associated with the packer boxes and a controller (14), that activates a selected one of the feeders at a time, in communication with a feeder for the purpose of determining the degree of filling of a packer box and controlling the supply speeds of the of the feeder system accordingly. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Osako by utilizing a controller that activates a selected one of the feeders at a time, as disclosed by Meier, for the purpose of determining the degree of filling of a packer box and controlling the supply speeds of the of the feeder system accordingly.

4. Claims 17-20, 22-24, 26, 29-30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osako et al. in view of Meier as applied to the claims above, and further in view of Harris, Jr. et al. Osako and Meier together disclose all the limitations of the claims, but the combination does not disclose that the feeder system includes a printer, at the output end of the conveyor, in communication with the controller. However, Harris, Jr. discloses a feeder system for a packer box (118) that includes a printer (40), at the output end of a feeder conveyor (12), in communication with a controller (22), for the purpose of printing a predetermined message on a signature (see col. 9, lines 20-22). I would have been obvious for a person of ordinary skill in the art, at the time of the applicant's invention to utilize a printer, at the output end of the conveyor, in communication with the controller, as disclosed by Harris, Jr., for the purpose of printing a predetermined message on a signature.

Allowable Subject Matter

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5. Claims 1-15 are allowed.

Response to Arguments

6. Applicant's arguments filed 10/14/05 have been fully considered but they are not persuasive.

7. The applicant states that one of ordinary skill in the art would not have been motivated to combine the teachings of Osaka and Meier. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Osaka by utilizing a controller that activates a selected one of the feeders at a time, as disclosed by Meier, for the purpose of determining the degree of filling of a packer box and controlling the supply speeds of the of the feeder system accordingly.

8. The applicant states that neither Osaka nor Meier teach or suggest the desirability of the claimed invention. The examiner agrees with the applicant's statement that neither reference teaches or suggests the invention alone. However, the combination of the two references both teaches and suggests the desirability of the claimed invention. If either Osaka or Meier separately taught or suggested the desirability of the claimed invention, the claims would have been rejected under 35 USC § 102 as anticipated by the prior art.

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9. The applicant states that Osaka does not disclose the desirability or the need to have a controller in communication with the feeders to activate a selected one of the feeders at a time.

The examiner agrees with the applicant. Meier discloses the desirability or the need to have a controller in communication with the feeders to activate a selected one of the feeders at a time.

10. The applicant states that, because Osaka does not disclose feeders that feed signatures for some books but not others, there would be no need to determine the degree of filling of a packer box. The examiner notes that, even if the applicant's assertion is correct, the degree of filling of a packer box would be influenced by other factors such as the thickness of the signature.

11. The applicant infers that Osaka teaches away from any modification because it would conflict with Osaka's intent to disclose a cost conscious, efficient bookbinding process. The examiner disagrees with the applicant. Modifying Osaka by utilizing a controller that activates a selected one of the feeders at a time, as disclosed by Meier, would render the device/method more efficient and less costly because the supply would only be activated when necessary.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (571) 272-6916.

The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick H. Mackey
Primary Examiner
Art Unit 3651

December 9, 2005